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Paper No. 37

BEUSSE BROWNLEE WOLTER MORA & MAIRE  
390 N. ORANGE AVENUE  
SUITE 2500  
ORLANDO FL 32801

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**DEC 22 2005**

**OFFICE OF PETITIONS**

In re Application of  
John F. Wironen et al.  
Application No. 08/816,079  
Filed: March 13, 1997  
Attorney Docket Number: TB-101  
Title: BONE PASTE

DECISION ON PETITION  
UNDER 37 C.F.R. §1.137(b)

This is a decision on the petition filed August 10, 2005, pursuant to 37 C.F.R. §1.137(b)<sup>1</sup>, to revive the above-identified application.

The above-identified application became abandoned for failure to reply within the meaning of 37 CFR §1.113 in a timely manner to the final Office action mailed December 21, 2001, which set a shortened statutory period for reply of three (3) months. On June 21, 2002, Petitioner submitted an improper Continued Prosecution Application (CPA). On July 29, 2002, Applicant's counsel "authorized the abandonment of the subject application<sup>2</sup>."

Along with the present petition, Petitioner has submitted the petition fee.

Petitioner has failed to meet the requirements set forth in 37 C.F.R. §§1.137(b)(1) and (3). The fourth requirement is not applicable.

Regarding the first requirement, the petition states that a continuation application was submitted along with the present petition. Office records do not reflect the receipt of an application on August 10, 2005 which claims priority to the present application. The undersigned attempted to

<sup>1</sup> A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional, and;
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

<sup>2</sup> Petition, page 2.

reach the Petitioner via telephone on December 20, 2005, but was informed that the same was on leave for an extended period of time.

Regarding the third requirement, Petitioner has failed to include the required statement "that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional." Petitioner will be required to make this statement with exacting precision.

Furthermore, it is noted that Petitioner has set forth that the file history was retrieved and it was determined that the present application was abandoned in January of 2005<sup>3</sup>, however the present petition was not submitted until August of that year. Petitioner will need to explain the reason(s) behind this portion of the delay.

For these reasons, the petition must be **DISMISSED**.

Any reply must be submitted within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 C.F.R. §1.136(a) are permitted. The reply should include a cover letter entitled "Renewed Petition Under 37 C.F.R. 1.137(b)". This is not a final agency action within the meaning of 5 U.S.C 704.

The renewed petition should indicate in a prominent manner that the attorney handling this matter is Paul Shanoski, and may be submitted by mail<sup>4</sup>, hand-delivery<sup>5</sup>, or facsimile<sup>6</sup>.

It is further noted that Petitioner has attempted to change the power of attorney. Petitioner's request will not be granted for the following two reasons.

First, Petitioner has failed to establish a right to take action, pursuant to 37 C.F.R. §3.73(c)(2), in that a review of the assignment records indicates that there are a plurality of assignees who each have rights to this application. Petitioner has merely set forth that The University of Florida Research Foundation, Inc. is a part owner. The percentage of the interest has not been revealed.

Secondly, The Manual of Patent Examining Procedure ("MPEP"), § 402.10, Appointment/Revocation by Less Than All Applicants or Owners, provides:

Papers giving or revoking a power of attorney in an application generally require signature by all the applicants or owners of the application. Papers revoking a power of attorney in an application (or giving a power of attorney) will not be accepted by the Office when signed by less than all of the applicants or owners of the application unless they are accompanied by a petition and fee under 37 CFR 1.182 giving good and sufficient reasons as to why such papers should be accepted. The petition should be directed to the Office of Petitions. The acceptance of such papers by petition under 37 CFR 1.182 will result in more than one attorney, agent, applicant, or owner prosecuting the application at the same time. Therefore, each of these parties must sign all subsequent replies submitted to the Office. See *In re Goldstein*, 16 USPQ2d 1963 (Dep. Assist. Comm'r Pat. 1988). In an application filed under 37 CFR 1.47(a), an assignee of the entire interest of the available inventors who have signed the declaration may appoint or revoke a power of attorney without a petition under 37 CFR 1.182. See MPEP § 402.07. However, in applications accepted under 37 CFR 1.47, such a petition under 37 CFR 1.182 submitted by a previously nonsigning inventor who has now joined in the application will not be granted. See MPEP § 409.03(i). Upon accepting papers appointing and/or revoking a power of attorney that are signed

<sup>3</sup> Petition, page 3.

<sup>4</sup> Mail Stop Petition, Commissioner for Patents, United States Patent and Trademark Office, P.O. Box 1450, Alexandria, VA, 22313-1450.

<sup>5</sup> Customer Window, Randolph Building, 401 Dulany Street, Alexandria, VA, 22314.

<sup>6</sup> 571-273-8300 - please note this is a central facsimile number.

by less than all of the applicants or owners, the Office will indicate to applicants who must sign subsequent replies. An indication will be placed on the file wrapper as to the number of signatures necessary for accepting subsequent replies and the paper number(s) where the split powers of attorney appear. Dual correspondence will still not be permitted. Accordingly, when the acceptance of such papers results in an attorney or agent and at least one applicant or owner prosecuting the application, correspondence will be mailed to the attorney or agent. When the acceptance of such papers results in more than one attorney or agent prosecuting the application, the correspondence address will continue to be that of the attorney or agent first named in the application, unless all parties agree. Each attorney or agent signing subsequent papers must indicate whom he or she represents.

The following are examples of who must sign replies when there is more than one person responsible for prosecuting the application:

(A) If coinventor A has given a power of attorney and coinventor B has not, replies must be signed by the attorney of A and by coinventor B.

***(B) If coinventors A and B have each appointed their own attorney, replies must be signed by both attorneys.***

The Office will continue to conduct correspondence with the attorneys first named in the application, Timothy Van Dyke and Joseph Fischer, of the law firm of Beusse Brownlee Wolter Mora & Maire, at the correspondence address of record noted above, who will also be responsible for coordinating replies or submissions to this Office. See, Manual of Patent Examining Procedure ("MPEP") 402.10.

It is noted that, notwithstanding this Decision, the inventors may still jointly appoint or revoke power of attorney.

Telephone inquiries regarding *this decision* should be directed to the undersigned at (571) 272-3225. All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Paul Shancski  
Senior Attorney  
Office of Patents  
United States Patent and Trademark Office